

THIS DISPOSITION IS NOT
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SEPT 3, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Leiner Health Products Inc.**

Serial No. 75/204,608

Michael A. Painter of Isaacman, Kaufman & Painter for **Leiner Health Products Inc.**

Leigh Caroline Case, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before **Simms**, **Hohein** and **Hairston**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Leiner Health Products Inc. has filed an application to
register the mark "SUPER E" for "vitamins and dietary food
supplements".¹

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis
that, when used in connection with applicant's goods, the mark
"SUPER E" is merely descriptive of them. Registration also has
been finally refused under Section 2(d) of the Trademark Act, 15

¹ Ser. No. 75/204,608, filed on November 26, 1996, which alleges a bona fide intention to use such mark in commerce. The term "E" is disclaimed.

U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its goods, so resembles the mark "SUPER C," which is registered for "non-prescription dietary supplements,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register.

Turning first to consideration of the issue of mere descriptiveness, applicant simply contends that "the mark SUPER E is, at most suggestive of the subject matter of Appellant's goods and, therefore, cannot be considered as being merely descriptive thereof." Applicant notes, as support for its position, that "one need only refer to the Certificate of Registration which was cited by the Examiner as a basis for refusing registration." Because such registration issued on the Principal Register, with a disclaimer of the term "C," applicant asserts that "[t]his clearly refutes the argument [that] the subject mark is merely descriptive of the goods or a feature thereof."

The Examining Attorney, on the other hand, argues that the mark "SUPER E" is merely descriptive of applicant's vitamins and dietary food supplements because such mark "merely combines a laudatory adjective indicating the superior quality of the applicant's goods with the generic term 'E,' which indicates vitamin E" (footnote omitted). Applicant, the Examining Attorney asserts, "does not contest the meanings of the terms 'super' and

'E' and, in fact, "has submitted a disclaimer of exclusive rights to use the term 'E.'" Furthermore, as shown by the copy thereof which accompanies her brief, the Examining Attorney points out that The American Heritage Dictionary of the English Language (3d ed. 1992) defines the word "super" in relevant part as an adjective meaning "1. Very large, great, or extreme ... 2. Excellent, first rate"³ In view thereof, the Examining Attorney concludes that "the applicant's combination of the term 'super' with the vitamin name 'E' is therefore unregistrable."

In addition, as to applicant's contention that its mark is not merely descriptive because the cited registration for the mark "SUPER C" contains only a disclaimer of the term "C," the Examining Attorney insists that each case must be decided on its own merits. "Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding upon the agency or the Board," the Examining Attorney maintains, citing *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes

² Reg. No. 1,785,179, issued on August 3, 1993, which sets forth dates of first use of October 1, 1992; combined affidavit §§8 and 15. The term "C" is disclaimed.

³ Inasmuch as it is settled that judicial notice may properly be taken of dictionary definitions, the request in the Examining Attorney's brief that the Board "take judicial notice of this dictionary definition" is granted. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, supra at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there

is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

Thus, it is perhaps not surprising that differing results have been reached in cases which involve marks containing the word "super". Such cases include, for instance: In re U.S. Steel Corp., 225 USPQ 750, 751 (TTAB 1985) ["SUPEROPE" viewed as merely descriptive of wire rope since "combination of the word 'SUPER' with the apt descriptive term 'ROPE' results in a term which would be perceived as nothing more than the name of the goods modified by a laudatory adjective indicating the superior quality of appellant's wire rope"]; In re Carter-Wallace, Inc., 222 USPQ 729, 730 (TTAB 1984) ["SUPER GEL" held merely descriptive of a "lathering gel for shaving" because term "would be perceived as nothing more than the name of the goods modified by a laudatory adjective indicating the superior quality of applicant's shaving gel"]; In re Samuel Moore & Co., 195 USPQ 237, 241 (TTAB 1977) ["SUPERHOSE!" found merely descriptive of "hydraulic hose made of synthetic resinous materials" since term "would be understood as the name of the goods modified by a laudatory adjective which would be taken to mean that applicant's

hose is of superior quality or strength"]; In re Ralston Purina Co., 191 USPQ 237, 238 (TTAB 1976) ["SUPER" in "RALSTON SUPER SLUSH" ("SLUSH" disclaimed) held suggestive of a "concentrate used to make a slush type soft drink" since the term "is used as mere puffery ... to connote a vague desirable characteristic or quality"]; Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) ["SUPER BLEND" held merely descriptive of "motor oils" as designating "an allegedly superior blend of oils"]; and In re Occidental Petroleum Corp., 167 USPQ 128 (TTAB 1970) ["SUPER IRON" found suggestive of "soil supplements" since "it takes some roundabout reasoning to make a determination ... that the product contains a larger amount of iron than most soil supplements or that this iron ... ingredient ... is superior in quality to iron found in other soil supplements"].

Nevertheless, it is possible to distill from such cases that, as a general proposition, if the word "super" in a mark is combined with the generic name of the goods, or if the goods which are sold under a mark containing the word "super" come in various grades or sizes, then the mark is merely descriptive rather than suggestive. In the present case, the term "SUPER" is combined with the generic name for a kind of vitamin, namely, E, and it is common knowledge that vitamins as well as dietary food supplements are available in various grades of strength, potency and/or purity. Applicant's "SUPER E" mark, therefore, would be immediately perceived by consumers as basically nothing more than the name of its goods, or a significant component thereof, which

is modified by a laudatory adjective indicating the superior quality of its goods or their exceptional strength, potency and/or purity. As such, the term "SUPER E" merely describes applicant's products and, while consistency of examination is of course desirable, the fact that the cited registration for the mark "SUPER C" issued on the Principal Register with only a disclaimer of the generic term C is not persuasive of a contrary finding.⁴ See, e.g., *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991).

Turning, then, to consideration of the refusal under Section 2(d), applicant argues that, "when considered in light of the lack of [a] relationship in [the respective] goods, the failure to consider Applicant's mark in its entirety" mandates reversal of the refusal to register. The Examining Attorney, however, accurately points out that "[t]he applicant and the registrant provide the same goods, dietary supplements," and it is clear that vitamins, being a typical component of or substitute for dietary supplements, are closely related goods and that the respective products would be marketed to the same classes of purchasers through the identical channels of trade. Plainly, if vitamins and non-prescription dietary supplements

⁴ As the Board has often stated, each case must be decided on its own facts. See, e.g., *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 221 (TTAB 1984) and *In re Inter-State Oil Co., Inc.*, 219 USPQ 1229, 1231 (TTAB 1983). We are not privy to the file history of the cited registration and thus have no way of knowing whether the registration initially involved a mere descriptiveness refusal which was subsequently overcome. Consequently, the determination of registrability by the Trademark Examining Operation for the mark "SUPER C" cannot control the result in this case.

were to be sold under the same or substantially identical marks, confusion as to source or sponsorship would be likely to occur.

Applicant contends, however, that when the marks "SUPER E" and "SUPER C" are considered in their entirety, the differences in the "non-common portions of the marks are sufficient to distinguish the marks" as to their commercial impression.⁵ We agree, however, with the Examining Attorney's analysis that "the applicant's mark SUPER E and the registrant's mark SUPER C are almost identical in sound, appearance, meaning, and connotation." Moreover, since in each instance, the terms "C" and "E" are generic (and have been disclaimed), consumers would look to the word "SUPER" in the marks as the dominant and source-indicative element. Both marks, furthermore, are identically structured, with the word "SUPER" followed by a vitamin name, and when considered in their entirety, project essentially the same commercial impression when used in connection with the respective goods.

We accordingly conclude that consumers, familiar with registrant's "SUPER C" mark for non-prescription dietary supplements, would be likely to believe, upon encountering applicant's substantially identical mark "SUPER E" for vitamins and dietary food supplements, that such identical and otherwise

⁵ Although applicant also maintains that "[t]he record indicates numerous composite marks which have been registered and/or allowed in International Class 5 and which include the word SUPER (e.g., SUPER FLEX ...; SUPER BEE POLLEN ...; SUPER HYDRATE ...; SUPER MAX ...; [and] SUPER VITE ALL ...)," no copies thereof were ever made of record and, in any event, none of such marks is as similar overall to applicant's mark as is registrant's mark.

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closely related products emanate from, or are sponsored by or affiliated with, the same source.

Decision: The refusals under Section 2(e)(1) and Section 2(d) are affirmed.

R. L. Simms

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board